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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/625,790	07/26/2000	Stuart W. Peltz	601-1-044DIV	8302

23869 7590 03/28/2005

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SYOSSET, NY 11791

EXAMINER
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STEADMAN, DAVID J

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 03/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

41C

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No. 09/625,790		Applicant(s) PELTZ ET AL.	
Examiner David J. Steadman		Art Unit 1652	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 07 March 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☒ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1-6,32,34,44-47,51 and 53.  
Claim(s) withdrawn from consideration: 7,33,35-43,48-50,52 and 54-56.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

David J. Steadman, Ph.D.  
Primary Examiner  
Art Unit: 1652

### ADVISORY ACTION

[1] The request for reconsideration in the response filed 3/7/2005 has been considered, however the amendment does not place the application in condition for allowance. The amendment to the claims filed 3/7/2005 would appear to overcome the rejection under 35 U.S.C. § 112, second paragraph and the written description and scope of enablement rejections under 35 U.S.C. § 112, first paragraph, as set forth in the Office action mailed 10/15/2004. Also, the amendment would likely result in rejoinder of Groups I-II as set forth in the Office action mailed 10/15/2004. However, the amendment has not been entered because the amended claims raise the issue of new matter and require further consideration and a new search. Exemplary reasoning for non-entry of the amendment is provided below.

[2] First, it is noted that MPEP § 2163 states: "when filing an amendment an applicant should show support in the original disclosure for new or amended claims" and "[i]f the originally filed disclosure does not provide support for each claim limitation, or if an element which applicant describes as essential or critical is not claimed, a new or amended claim must be rejected under 35 U.S.C. 112, para. 1, as lacking adequate written description". The examiner has reviewed applicants' remarks for a showing of support for, *e.g.*, newly added claim 64. The examiner can find no such showing.

[3] Second, even assuming *arguendo* a showing of support for claim 64 can be found in the amendment filed 3/7/2005, the limitation presented therein is a new limitation that would require a new search and further consideration.

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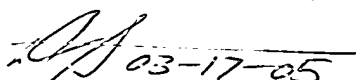
[4] Third, it is not clear from the method of claim 57 as to whether the eukaryotic cells exposed to a compound are infected with a virus or not. As such, the claim is unclear and a new rejection under 35 USC 112, second paragraph, would be necessitated by entry of the amendment.

[5] Applicants' arguments in the amendment filed 3/7/2005 have been fully considered. However, in view of the non-entry of the amendment, applicants' arguments are not found persuasive to overcome the outstanding rejections as set forth in the Office action mailed 10/15/2004 for the reasons of record stated therein. Further, in view of the non-entry of the amendment, applicants' arguments are not found persuasive to overcome the restriction requirement as set forth in the Office action mailed 10/15/2004. Even if the amendment were entered, the rejection under 35 U.S.C. § 102(b) and the rejection under 35 U.S.C. § 102(b)/103 would likely be maintained.

[6] In view of the non-entry of the amendment, the claim status is as follows:

- Claims 1-7 and 32-56 are pending.
- Claims 7, 33, 35-43, 48-50, 52, and 54-56 are withdrawn from consideration.
- Claims 1-6, 32, 34, 44-47, 51, and 53 are rejected.
- No claim is in condition for allowance.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Steadman, whose telephone number is (571) 272-0942. The Examiner can normally be reached Monday-Thursday and alternate Fridays from 6:30 am to 4:00 pm. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Ponnathapura Achutamurthy, can be reached at (571) 272-0928. The FAX number for submission of official papers to Group 1600 is (571) 273-8300. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Art Unit receptionist whose telephone number is (703) 308-0196.

  
03-17-05  
DAVID J. STEADMAN, Ph.D.  
PRIMARY EXAMINER